#46/5

Attorney Docket Number 2000.602 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

EGBERINK ET AL

Serial Number: 10/054,458 Group Art Unit: 1615

Filed: November 21, 2001 Examiner: Yvonne R. Abbott

For: PHARMACEUTICAL FORMULATION OF GEPIRONE FOR ORAL ADMINISTRATION

RESPONSE TO THE DECISION ON REQUEST UNDER 37 C.F.R 5.25

Assistant Commissioner of Patents
Washington, D.C. 20231

September 18, 2002

Sir:

In the Decision on Request Under 37 C.F.R 5.25 mailed July 29, 2002, the Examiner concluded that "[t]here appears to be no error as to why the material was first filed abroad." To reach this decision the Examiner concluded, based on the information provided in a Declaration by Dr. Broekkamp that "[i]t appears that it was merely reliance on European law and not lack of knowledge of the requirements of U.S. laws that prevented a thorough investigation of inventorship. Having knowledge of U.S. foreign filing requirements should have urged the investigation of inventorship prior to filing even though not required by European law. Not determining inventorship until later in the prosecution process in not within the meaning of 'error' as provided in 37 C.F.R. 5.25 (a)(3)(iii). Thus, in the absence of the declaration explaining why the material was filed abroad through error, the provisions of 37 C.F.R. 5.25 have not been met."

It is respectfully submitted that the filing of the European application and following the practice of later determining inventorship by Dr. Broekkamp was, in fact, because of a lack of knowledge of the requirements of U.S. law at the

time of the European filing. It was not until later that he learned of the U.S. foreign filing requirements.

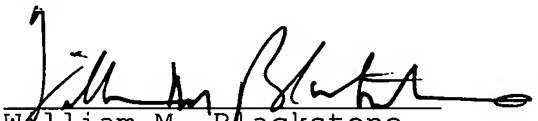
In Dr. Broekkamp's Declaration signed May 7, 2002, he states "[o]nly much later after the first filing in Europe, I realized that a U.S. inventor was involved and that the invention was not made exclusively outside U.S. territory. Only then did I realize that the application should have been filed in the United States." He then goes on to describe the procedures in his department in the Netherlands for determining inventorship. Dr. Broekkamp followed the standard procedure at the time of the European filing. He then stated: "[f]ollowing this procedure, I realized later that a U.S. inventor was involved and that the invention was not made exclusively outside U.S. territory. Consequently, I realized that the first filing should have been made in the U.S." From this, it was concluded that Dr. Broekkamp was aware of the U.S. requirements at the time of the European filing.

In the Supplemental Declaration submitted herewith Dr. Broekkamp explains the above statement and declares that at the time of the European filing he was not aware of the requirement that a license for foreign filing must first be obtained from the Commissioner of Patents if an application for a patent is to be filed in any foreign country prior to six months after filing in the United States (if the invention was made in the United States). He learned of this requirement from a colleague after the European filing and at about the time of making the inventorship determination. Accordingly, Dr. Broekkamp, at the time of making European filing did lack the knowledge of the requirements of U.S. laws and, thus, the European filing was made through error and without deceptive intent. Not only was he not aware of the U.S. filing requirements, but he was also not aware the invention was partially made in the United States. As he reports, this was his first experience with an invention wholly or partially made in the United States, all of his experience to

that time was with inventions made in European research facilities.

It is respectfully submitted that the proscribed filing was made without knowledge of the U.S. requirements and that alone meets the meaning of "error" as provided in 37 C.F.R. § 5.25 (a)(3)(iii). It is respectfully requested, in view of the statements in the Supplemental Declaration submitted herewith, that the Petition for Retroactive License Under 37 C.F.R § 5.25 be reconsidered and a retroactive foreign filing license be granted.

Respectfully submitted,



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On: September 18, 2002

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Typed or Printed Name **William M. Blackstone**

USSN 10/054,458
Attorney Docket Number 2000.602 US

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Supplemental Declaration Under 35 C.F.R. 55.25 (3) (3 pages)
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